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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,843

02/17/2005

Yasuyuki Kawahara

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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

04/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,843	<b>Applicant(s)</b> KAWAHARA ET AL.	
	<b>Examiner</b> James Goloboy	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7, 10, 13-23 is/are rejected.
- 7) ☒ Claim(s) 8,9,11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. Claims 1, 5, 7, 10, 13-18, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Papay.

This rejection is adequately set forth in paragraph 3 of the office action mailed 7/2/07, which is incorporated here by reference.

2. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Papay as applied to claims 1, 5, 7-18, and 20-22 above, and further in view of Cook.

This rejection is adequately set forth in paragraph 4 of the office action mailed 7/2/07, which is incorporated here by reference.

3. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Papay as applied to claims 1, 5, 7-18, and 20-22 above, and further in view of Rudston.

This rejection is adequately set forth in paragraph 5 of the office action mailed 7/2/07, which is incorporated here by reference.

### ***Allowable Subject Matter***

4. Claims 8-9 and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has submitted a declaration under 37 CFR 1.132, signed by Kawamura and dated 12/20/07, that, in combination with the data reported in the specification, shows that compositions where the base oil is a diester of 3-methyl-1,5-pentanediol and n-heptanoic, n-octanoic, nonanoic, and n-decanoic acid and mixtures thereof, display unexpectedly superior heat resistance in comparison with the closest prior art, compositions containing a base oil made from 3-methyl-1,5-pentanediol and n-hexanoic acid.

#### ***Response to Arguments***

5. Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive. Applicant argues that Wilson does not disclose the claimed diester, noting that hexanoic acid is a C<sub>6</sub> fatty acid and 2-ethylhexanoic acid is not a linear acid. However, as noted in paragraph 3 of the office action mailed 7/2/07, Wilson also discloses similar acids to those explicitly disclosed ("and the like", column 3 line 68). As Wilson discloses a linear C<sub>6</sub> acid, a linear C<sub>7</sub> acid is clearly within the scope of "and the like", and therefore rendered obvious. Applicant further argues that there is no incentive to use the corrosion inhibitors of Cook in the composition of Wilson because the composition of Cook uses a different base fluid. Corrosion inhibitors are useful additives regardless of the base fluid. Applicant similarly argues against the inclusion of the

gallate corrosion inhibitors of Rudston in the composition of Cook, arguing that lead corrosion would not be expected in applications of the claimed bearing lubricant. It is noted that the limitation of claim 1 that the lubricating oil be for bearings is an intended use recitation, and as the compositions formed from the combination of the cited references are capable of lubricating bearings, that limitations of the claims is met. It is further noted that the lubricants of the references are also useful in engines, where corrosion inhibitors are useful additives.

Applicant has also submitted a declaration under 37 CFR 1.132, signed by Kawahara and dated 12/20/07, that alleges to demonstrate unexpectedly superior results arising from the claimed compositions. While the examiner agrees that unexpected results have been established for the esters of claims 8-9 and 11-12, the compositions with which the results were obtained are not commensurate with the scope of the remaining claims, as they are achieved with specific esters formed from specific diols and alcohols, while the claimed esters can be obtained from several types of diols for which results have not been reported.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797

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